26.   [Amended] A computer readable medium having stored thereon a data structure comprising:

a first data field containing data representing a card object containing data and commands for use by a personalization server to control the programming of a portable programmed data carrier by a personalization station; and

a second data field containing data representing a unique card object identifier for [identifying] use by the personalization server to identify the card object represented by the first data field in response to a programming request from the personalization station.

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on October 5, 1999, and the references cited with it. By the above amendments, limitations have been added to define the invention more particularly and distinctly and to define the invention patentably over the references. Claims 10 and 26 are amended. Claims 1-35 remain pending in this application. Applicant respectfully requests reconsideration of the above-identified patent application as amended and in view of the following remarks.

§103 Rejection of Claims

The Rejection of Claims 1-25 and 27-35 over Linden in View of Laing is Overcome

The October 5, 1999, Office Action rejected claims 1-35 under 35 U.S.C. 103(a) as being unpatentable over Linden (4,827,425) in view of Laing et al. (5,534,857).   Claim 10 has been amended to define patentably over these references and any combination of them. Applicant requests reconsideration of this rejection for the following three reasons.

(1)   *Linden, Laing, and their Combination Do Not Meet All of the Claimed Features.* Even if combined, the references would not meet the claims.

(2)   *Omission of an Element in Laing Makes it Simpler.* An element of Laing has been omitted in the claimed invention and made simpler without loss of capability.

(3)   *A Prima Facie Case of Obviousness Has Not Been Established.* The

AMENDMENT AND RESPONSE
Serial Number: 09/076,022
Filing Date: May 11, 1998
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October 5, 1999, Office Action did not show why the claimed subject

matter as a whole, including its differences over the prior art, would have

been obvious.

Linden, Laing, and their Combination Do Not Meet All of the Claimed Features

Linden, Laing, and the claimed invention show three different perspectives of smart card

personalization. Linden views smart cards from the manufacturers perspective, Laing views

smart cards from the retailer's perspective, and the claimed invention views smart cards from the

issuer's perspective. Consequently the subject matter is not identical in all respects. Linden

discloses the flow of a factory for initially creating smart cards. Laing discloses how a retailer

would set up a smart card for a customer. The claimed invention details how an issuer controls

smart card personalization in a multistation environment.

No card issuer management system. To illustrate this different perspective of the claimed

invention, claims 1, 15, 21, and 30 include the act of "receiving a card object from a card issuer

management system" that is not disclosed in Linden or Laing. The card issuer management

system manages the cardholder data and determines the type of card to issue, the card

applications to embed in the card, and what personalization equipment to use to issue the card for

a particular cardholder. (Applicant's Specification, page 7, lines 10-12). Linden does not

disclose any selective programming of this sort. Instead, the cards are programmed with data

corresponding to the data encoded on the magnetic strips earlier in the assembly line. (Linden,

col. 3 line 65 to col. 4 line 12). Rather than determine the type of card to issue, Laing presumes

two types of smart cards (retailer smart cards and customer smart cards) already exist and does

not disclose how they were personalized. (Laing, col. 2 lines 33-40; col. 3 line 62-64; col. 4 line

8). Additionally, both Linden and Laing fail to disclose variations in personalization equipment

or any selection of such equipment.

No programming request. The method of claim 1 includes "receiving a programming

request from one of the personalization stations". There is no programming request in Linden.

In contrast, it is assumed that all of the cards are to be programmed as they travel through the in-

feed, rotate once around the circular programming table, and then exit through the out-feed.

(Linden, col. 3 line 38 to col. 4 line 37). Although Laing has a request, it is not from a

"personalization station" so the limitation of claim 1 is not met. In Laing, the retailer initiates the personalization by setting up a communication link from the Data Terminal Device (DTD) to the Administration System (ADS) and then signing on. (Laing, col. 4 lines 24-35). The Secure Terminal Device (STE) is the closest thing to a "personalization station" because it reads and writes to smart cards but it is not involved in initiating the personalization. (Laing, Fig. 1 element 7, col. 3 lines 48-52). The DTD is not like a personalization station; it is more like a middleman that relays messages without reading them from the ADS to the STE. Only two communication links are set up: one between the ADS and the DTD and another between the DTD and the STE. Therefore, there is no direct communication link between the ADS and the STE. (Laing, Fig. 1; col. 3 lines 42-52; col. 5 lines 38-46).

Similarly, amended claim 10 includes "controlling the programming of the portable programmed data carriers in response to a request from one of the personalization stations" and thus has the same programming request limitation not found in either Linden or Laing. Additionally, claim 15 includes "a programming request from the personalization station"; claim 21 includes "receiving a programming request from one of the personalization stations"; amended claim 26 and claim 27 both include "in response to a request from one of the personalization stations"; claim 29 includes "requesting, by the personalization station, from the server, information for programming"; and claim 30 includes "receiving, by the server, a programming request from one of the personalization stations". Therefore, claims 10, 15, 21, 26, 27, 29, and 30 are distinguishable over Linden and Laing by the programming request limitation.

Omission of an Element in Laing Makes it Simpler

As noted above, Laing has a DTD which acts as a middleman relaying messages from the ADS to the STE without reading them. In essence, the DTD acts as a dumb terminal during programming. The claimed invention does away with this middleman, making the programming more direct and simpler without loss of capability. For example, in claim 27, the server communicates directly with the personalization station by transferring data and commands to it for programming the portable programmed data carriers. One element of claim 27 is:

> a personalization server for controlling the programming of a portable
> programmed data carrier in response to a request from one of the personalization
> stations, wherein the personalization server translates the card object into

commands and data and transfers the commands and data to the personalization stations making the request.

A Prima Facie Case of Obviousness Has Not Been Established

Linden, Laing, or their combination must teach or suggest all of the claim limitations to establish a prima facie case of obviousness. See MPEP 706.02(j). The eight remaining independent claims: 1, 10, 15, 21, 26, 27, 29, and 30 contain features not disclosed by either Linden or Laing as shown above. Therefore, a prima facie case of obviousness has not been established. Furthermore, a prima facie case of obviousness has not been established for claims 2-9, 11-14, 16-20, 22-25, and 28 which depend from the patentably distinct independent claims.

Conclusion

Applicant respectfully submits that the amended claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-349-9592) to facilitate prosecution of this application.

If necessary please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Assistant Commissioner of Patents, Washington, D.C. 20231 on January 5, 2000.

CANDY BUENDING   _[Signature]_
Name   Signature